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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/592,975	09/15/2006	Fumihiko Mizukami	CU-5078 BWH	3770

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EXAMINER	
MCCLELLAND, KIMBERLY KEIL	
ART UNIT	PAPER NUMBER
1791	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/592,975	MIZUKAMI ET AL.	
	Examiner	Art Unit	
	KIMBERLY K. MCCLELLAND	1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03/03/10*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10* is/are pending in the application.

4a) Of the above claim(s) *6-10* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *15 September 2006* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Election/Restrictions

Response to Amendment

1. Applicant is reminded they need to explicitly point out where support for all the newly claimed features comes from as required by MPEP 714.02 and 2163.06. See 37 CFR 1.111.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: transferring a thermal sheet.

4. Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term “parallax information” in unclear. The specification does not describe this term. The drawings do not illustrate this feature. Examiner notes parallax information may be formed by altering observer position. It appears inherent that parallax information is present in every direction. Clarification is requested as to what features are being recited.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent NO. 5,744,219 to Tahara.

7. With respect to claim 1, Tahara discloses a foil transfer method, including a moving a heat source of a unit area in a predetermined direction, wherein the predetermined direction of the heat source is set to be a direction in which parallax information exists (column 14, lines 61-64 and Figure 9).

8. Examiner notes a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

9. As to claim 2, Tahara discloses the heat source is a heat generation element of a thermal head (column 14, lines 61-64).

10. Claims 1-2 and 4-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent Application Publication No. 08-258437 to Tawara (machine translation provided).

11. With respect to claim 1, Tawara discloses a foil transfer method, including a moving a heat source (see paragraph 0004) of a unit area in a predetermined direction (i.e. horizontal), wherein the predetermined direction of the heat source is set to be a direction in which parallax information exists (i.e. horizontal; See paragraphs 0015, 0008-0010 and Figure 1).

12. Examiner notes a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

13. As to claim 2, Tawara discloses the heat source is a heat generation element of a thermal head (See paragraph 0004).

14. As to clam 4, Tawara discloses the hologram is a rainbow hologram (See paragraph 0016).

15. As to claim 5, Tawara discloses the hologram is a computer hologram having interference patterns each being formed as band-shaped element range (See paragraph 0015; and 0026).

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

17. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent NO. 5,744,219 to Tahara as applied to claims 1-2 above, and further in view of U.S. Patent Application Publication No. 2002/0168513 to Hattori et al.

18. As to claim 3, Tahara does not specifically disclose the heat source is a laser.

19. Hattori et al. discloses an imaging method, including in the art of holographic transfer (See paragraph 0225) it is known as an art-recognized equivalent to substitute a laser for a thermal head as a source of heat during thermal transfer (See paragraph 0211). It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the art-recognized equivalent laser for the thermal head heat source disclosed by Tahara.

20. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Application Publication No. 08-258437 to by Tawara (machine translation provided) as applied to claims 1-2 and 4-5 above, and further in view of U.S. Patent Application Publication No. 2002/0168513 to Hattori et al.

21. As to claim 3, Tawara does not specifically disclose the heat source is a laser.

22. Hattori et al. discloses an imaging method, including in the art of holographic transfer (See paragraph 0225) it is known as an art-recognized equivalent to substitute a laser for a thermal head as a source of heat during thermal transfer (See paragraph 0211). It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the art-recognized equivalent laser for the thermal head heat source disclosed by Tawara.

Response to Arguments

23. Applicant's arguments with respect to claims 1-5 have been considered but are moot in view of the new ground(s) of rejection. Applicant's remaining pertinent arguments are addressed below:

24. In light of the current amendment, the previous rejections under 35 U.S.C. 112 have been withdrawn. However, the new amendment necessitated new grounds of rejection under 35 U.S.C. 112.

25. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

26. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a transfer method, a relief pattern, applying heat, a thermal head, determining the direction in which parallax information exists, heating at the moment of transfer, limiting

imperfections in the surface, enhancing the desired optical effects, the direction in which the desired optical effect is obtained) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

27. Examiner notes the currently claimed method only requires a moving heat source of a unit area in a direction in which parallax information exists, which as noted above, appears to be any direction. Applicant's arguments do not address how the prior art references fail to cite every claimed feature. Applicant's arguments are almost exclusively drawn to features which are not recited in the current claim language. Therefore, these arguments are not persuasive.

28. With respect to applicant's request for rejoinder, examiner notes claims 6-10 are not dependent on independent claim 1, as explained in the restriction requirement filed 09/21/09. " Firstly, by "dependent" claim is meant a claim which contains all the features of one or more other claims and contains a reference, preferably at the beginning, to the other claim or claims and then states the additional features claimed (PCT Rule 6.4). The examiner should bear in mind that a claim may also contain a reference to another claim even if it is not a dependent claim as defined in PCT Rule 6.4. One example of this is a claim referring to a claim of a different category. Consequently, claims 6-10 are not found to be dependent claims." Therefore, claims 6-10 are not found to be dependent, as asserted by applicant.

Conclusion

29. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KIMBERLY K. MCCLELLAND whose telephone number is (571)272-2372. The examiner can normally be reached on 8:00 a.m.-5 p.m. Mon-Thr.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Philip C. Tucker can be reached on (571)272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kimberly K McClelland/
Examiner, Art Unit 1791

KKM

/Philip C Tucker/
Supervisory Patent Examiner, Art Unit 1791